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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,631	09/26/2001	Klaus-Helmut Muller	Mo-6595/LcA33,628	2092

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BAYER CROPSCIENCE LP  
100 BAYER ROAD  
PITTSBURGH, PA 15205

EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,631

Applicant(s)

MULLER ET AL.

Examiner

Andrea D Small

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) parts of 2-3 and 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 2-4 and 6-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *I. Applicants response:*

Applicant's response filed 3/24/2003 has been received and entered as paper no. 6.

### *II. Amendments:*

(a) Claims 1 and 5 have been cancelled.

(b) Claim 11 has been newly added.

(c) Pending claims are 2-4 and 6-11.

### *III. Restriction/Election:*

(a) The restriction outlined in paper no. 4, dated 11/18/2002 has been revised as follows:

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 2-3 and 6-10, drawn to compounds of claim 2 wherein Z is a four membered N containing ring.

Group II, claim(s) 2-4 and 6-11, drawn to compounds of claim 2 wherein Z is a five membered N containing ring.

Group III, claim(s) 2-3 and 6-10, drawn to compounds of claim 2 wherein Z is a six membered N containing ring.

Group IV, claim(s) 2-3 and 6-10, drawn to compounds of claim 2 wherein Z is a seven membered N containing ring.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The claims contain a 4-carboxyphenyl-1,2 diazole group that can be taken as a whole common with all the groups (non-varying moiety), this technical feature does not provide a contribution over the art as it was known in the art prior to the filing of the instant application, thus is not a 'special technical feature' under PCT rules 13.1 and 13.2. Therefore, unity of invention is lacking and the restriction is proper.

**(b) Applicants arguments with the holding that the presented claims lack unity of invention:**

(i) Applicants have argued that examining the entire scope of the invention in one application would not impose a serious burden on the office. Burdensome search is NOT a criteria employed when evaluating whether claims lack unity of invention under PCT rules 13.1 and 13.2. However, if such a criteria were to be employed, searching the entire scope of the instant claims in one application would impose a serious burden on the office because each of the aforementioned groups require separate database searches based on their distinct classifications AND each group would require separate electronic database searches and separate searching strategies that are not co-extensive.

(ii) Applicants argue that the claims presented have a special technical feature if the technical feature that can be taken as a whole is the one depicted on page 18 of Applicants response. The Examiner respectfully disagrees. The technical feature common to all the aforementioned groups which can be taken as a whole, i.e., moieties that would not vary from one group to another, is the 4-carboxyphenyl-1,2-diazole moiety. This moiety was known in the art prior to the filing of the instant application, see WO 98/31681, therefore, this technical feature does not provide a contribution over the art and hence is not a 'special technical feature' under the PCT rules 13.1 and 13.2.

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(iii) Applicants quoting MPEP section 1893.03(d) assert that the International Search Authority, International Preliminary Examination Authority and the designated and elected offices should determine unity of invention in accordance with Annex B when analyzing Rule 13 and concluded that if any one of the authorities holds that unity of invention is present then so should all the other aforementioned authorities. The examiner agrees with this assertion, but does not agree with the conclusion. Determining unity of invention in accordance with Annex B has been made; neither the MPEP nor the PCT asserts that the conclusions reached upon the application of Annex B should necessarily be the same for the ISA, IPEA, designated office or the elected office. The evaluation of the scope of the claims and the requirements of PCT rules 13.1 and 13.2 have been determined and a conclusion that the instant application lacks unity has been asserted and evidenced supra. Additionally, the examples of Markush practice indicated in the Administrative Instructions are just that, examples. They are used as a guide to determine unity of invention, they are not rules. Instantly, the determination has been made that these claims lack unity of invention based on the application of PCT rule 13.1 and 13.2.

For the above reasons and the reasons of record, it is concluded that unity of invention in the instant case is lacking and thus the aforementioned restriction is proper.

(c) Applicants have elected a compound set forth in Example III-3 with traverse. This example III-3 falls within the scope of group II and hence, group II, claims 2-4 and 6-11, drawn to compounds of claim 2 wherein Z is a five membered N containing heterocycle is examined herein. Parts of claims 2-3 and 6-10 not drawn to this group are withdrawn from consideration as being drawn to non-elected subject matter. 37 CFR 1.142(b).

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**IV. Objections:**

- (a) Claim 2: the phrase "(alkylene)" in claim 2 is redundant. Amending the claim to delete said phrase is suggested to obviate the above objection.
- (b) Claim 3: The phrases "(ethane-1, 1-diyl)" and "(ethane-1, 2-diyl)" are redundant. Amending the claim to delete said phrases is suggested to obviate the above objection.
- (c) Claims 2-3 and 6-10 are objected to as containing non-elected subject matter. These claims drawn solely to the elected group and overcoming any other objection would appear allowable.

**V. Contact Information:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

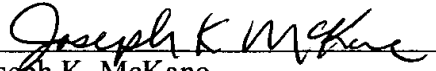
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
April 4, 2003

  
Joseph K. McKane  
Supervisory Patent Examiner  
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